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UNITED STATES DEPARTMENT OF COMMERCE  
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#8

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In re Application of: LAUK  
Application No. 08/981,924  
PCT No.: PCT/DE96/01269  
Int. Filing Date: 12 July 1996  
Priority Date: 12 July 1995  
Attorney Docket No.: P29411 WO US  
For: METHOD FOR DETERMINING THE  
EFFECTIVENESS AND TOLERANCE OF  
A XENOGENEIC SUBSTANCE  
ADMINISTERED TO AN ORGANISM

DECISION ON  
RENEWED  
PETITION UNDER  
37 C.F.R. 1.137(a)

This is in response to applicant's RENEWED PETITION TO REVIVE UNDER 37 CFR 1.137(a) received 20 May 1999 that seeks revival of the application on the grounds of unavoidable delay.

The renewed petition is **DISMISSED** without prejudice.

**BACKGROUND**

On 12 July 1996, applicant filed international application PCT/DE96/01269 claiming priority to an earlier German application filed 12 July 1995. A copy of the international application was timely communicated to the United States Patent and Trademark Office (PTO) from the International Bureau. A DEMAND for international preliminary examination, in which the United States was elected, was filed on 05 February 1997. Accordingly, the thirty month period for paying the basic national fee in the United States of America expired at midnight on 12 January 1998.

On 13 January 1998, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States under 35 U.S.C. 371, accompanied by, *inter alia*, the requisite basic national fee, a declaration of the inventor and an English language translation of the international application.

On 06 April 1998, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) to inform the applicant that all the requirements of 37 CFR 1.495 had been satisfied and that the application was accepted for entry into the national stage in the United States as of 13 January 1998.

On 06 October 1998, a communication was mailed to applicant, informing that the full basic national fee was not paid by the expiration of the statutory thirty month deadline from the priority date claimed of 12 July 1995. Accordingly, applicant had not met the requirements under 35 U.S.C. 371 and the Notification of Acceptance of Application of 06 April 1998 was issued in error.

On 22 October 1998, the PTO received from applicant a petition under 37 CFR 1.137(a) to revive an unavoidably abandoned application, accompanied by, *inter alia*, the requisite small entity petition fee, a second or subsequent transmittal letter to the DO/EO/US concerning a filing under 35 U.S.C. 371, the requisite surcharge for furnishing the oath or declaration, and the processing fee for furnishing the English translation later than thirty months from the earliest priority date. The petition alleged that the application became unavoidably abandoned due to an unexpected delay in the delivery of the Transmittal Letter and basic national fee to the DO/EO/US.

On 30 March 1999, the PTO mailed a Decision on Petition dismissing applicant's petition to revive under 37 CFR 1.137(a). The Decision indicated that the applicant had not provided evidence of the date and time the papers were delivered to Federal Express and that there was no evidence provided from Federal Express as to how long it should take to deliver a package from Germany to the PTO and therefore applicant did not meet the burden of establishing that the delay was unavoidable.

On 20 May 1999, the PTO received a RENEWED PETITION TO REVIVE UNDER 37 CFR 1.137(a) again requesting that the abandonment be considered unavoidable and that the application be revived. The renewed petition included a Federal Express invoice indicating dispatch of a package from Paul J. Vincent in Stuttgart, Germany to the PTO on 08 January 1998 and delivery to the PTO on 13 January 1998. The renewed petition also included a letter from Federal Express indicating that the mail time for a package from Germany to the United States is two work days.

### DISCUSSION

37 CFR 1.137(a), Revival of abandoned application or lapsed patent, in part, states:

Where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in § 1.17(1);

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

Applicant has satisfied items (1) and (2) and, as to item (4), since the application was filed after 08 June 1995, a terminal disclaimer is not required.

As to item (3), applicant's renewed petition provides evidence that papers addressed to the PTO were deposited with Federal Express in Stuttgart, Germany on 08 January 1998 and that the standard delivery time for packages from Germany to the United States by Federal Express is 2 work days. Firstly, there is no evidence that the Federal Express invoice corresponds to the 35 U.S.C. 371 application papers received by the PTO on 13 January 1998 and assigned application number 08/981,924. Therefore, the applicant has not provided evidence that Form PTO-1390 and the basic national fee were forwarded from Germany to the PTO on 08 January 1998. Additionally, the delay is not considered unavoidable. Since the standard delivery time from Germany to the United States is two work days as evidenced by the letter included in applicant's renewed petition and the papers were allegedly deposited on Thursday 08 January 1998, two work days (assuming Saturday and Sunday are not work days) would have the papers arriving at the PTO on Monday 12 January 1998, the last day of the thirty month period for submitting the basic national fee. A one day mailing or shipping delay can not be considered an unexpected or unforeseen fault or imperfection of the delivery service and the shipment of a package on the last possible day which would ensure its timely delivery is less than the care or diligence generally used and observed by careful men in relation to their most important business. See MPEP 711.03(c) III. C. 2.

### CONCLUSION

For the reasons above, applicant's petition is **DISMISSED** without prejudice.

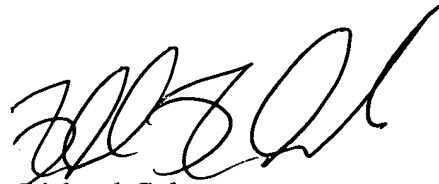
The application remains ABANDONED.

Applicant is hereby afforded TWO (2) MONTHS from the mailing date of this decision to submit a request for reconsideration of this decision or to request other appropriate relief, e.g. a petition to revive under 37 CFR 1.137(b). Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, with contents of the letter marked to the attention of the PCT Legal Office.



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